Hovsepian v. Apple, Inc.

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EXHIBIT B

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KAYE SCHOLER LLP
DAVID S. BENYACAR
DANIEL L. REISNER
425 Park Avenue
New York, NY 10022-3598
Telephone: (212) 836-8000
Facsimile: (212) 836-8689
dbenyacar@kayescholer.com
dreisner@kayescholer.com

Attorneys for Defendant
TIME WARNER CABLE INC.

GOODWIN PROCTER LLP
BENJAMIN HERSHKOWITZ
JOHN F. PETRSORIC
599 Lexington Avenue
New York, NY 10022
Telephone: (212) 813-8800
Facsimile: (212) 355-3333
bhershkowitz@goodwinprocter.com
jpetrsoric@goodwinprocter.com

Attorneys for Defendant
CSC HOLDINGS, INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

In Re

ACADIA MEDIA TECHNOLOGIES CORPORATION

Case No. C-05-0114JW

ROUND 3 DEFENDANTS' CLAIM CONSTRUCTION BRIEF (PART I)

Date: June 2, 2006
Time: 9:00 a.m.
Courtoom: 8, 4th Floor
Judge: Honorable James Ware

Claim 19's reliance on its preamble to provide antecedent basis for terms in the body of the claim is even more extensive than the claim at issue in *Bell Communications Research v. Vitalink Communications*, 55 F.3d 615 (Fed. Cir. 1995), where the court found the preamble limiting. The preamble in *Bell Communications* recited a "method for transmitting *a packet* . . . said packet including a source address and a destination address." The body of the claim contained two elements which referred to "said packet," thereby relying on the preamble for antecedent basis. *See* 55 F.3d at 621 ("assigning, by said source device, one of said trees to broadcast *said* packet and associating with *said* packet an identifier indicative of said trees"). The patentee argued that the preamble was not a limitation. The Federal Circuit disagreed, holding that the reference to "said packet" in the body of the claim incorporated the entire description of the packet from the preamble into the claim as limitations:

> These two steps of the claimed method, by referring to "*said* packet," expressly incorporate by reference the preamble phrase "said packet including a source address and a destination address." As a result, only a method for transmitting packets that have *both* source *and* destination addresses can literally infringe [the claim]. *Id.* at 621.

See also Electro Sci. Indus. v. Dynamic Details, Inc., 307 F.3d 1343, 1348 (Fed. Cir. 2002) ("References throughout the rest of the claim to 'circuit boards' rely upon and derive antecedent basis from this preamble language. Therefore, this preamble definition limits the term 'circuit boards' throughout the claim.")

Here, as discussed above, the body of claim 19 relies on the preamble for antecedent support of *four terms* used in the body of the claims, not just one as in *Bell Communications*. Thus, the "antecedent basis" guidepost alone demonstrates that the preamble of claim 19 is limiting.

b. the preamble recites important steps

A second guidepost used by courts to determine when a preamble limits a claim is whether the preamble recites important structure or steps. "[W]hen reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation." *Catalina Marketing*, 289 F.3d at 808. The preamble of claim 19 adds to the method described in the body of the claim the requirement that (i) "items . . . containing information" are located in the transmission system; and (ii) the user "request" must identify such "items." The patent specification repeatedly emphasizes that user identification of an item containing information (a physical item in the source material library)[9], and not the information itself (as stored, for example, in the compressed data library), is an important aspect of the invention. The specification says:

- "the present invention comprises a receiving system responsive to a *user input identifying a choice of an item stored in a source material library* to be played back to the subscriber at a location remote from the source material library, *the item containing information* to be sent from a transmitter to the receiving system" (Col. 2:62-68);

- "the first step of the distribution method 400 involves *retrieving the information for [sic from] selected items in the source material library 111, upon a request by a user* of the distribution system (step 412). " (Col. 18:53-56.)[10]

Consistent with the importance the applicants placed on this aspect of the invention, they relied on it to distinguish prior art. For example, they distinguished their invention from a prior art Lang patent on the grounds that "Lang does not teach that user requests will cause items stored in a source material library to be sent from a transmitter to a receiving system." (Petition to Make Special, Benyacar Decl. Ex. B, p. 7; *see also* '992 Col. 1:48-56.) The applicants also stated that

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9 See Point I (C) *infra.*

10 While describing the process for retrieving information in response to user requests, the specification sometimes states that user requests are made to the source material library, and at other times states that user requests are made to the compressed data library. These are not descriptions of alternative methods; they are self-contradictory descriptions of the same method. The two consecutive paragraphs at 18:46-59, for example, describe the same method 400 depicted in Figure 7. The first paragraph says "[m]ethod 400 assumes that the items have already been stored in compressed data library 118" (18:50-52), while the second paragraph says "the first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by the user of the distribution system." Claim 19 closely tracks this description of method 400. Claim 19, like the specification, describes a single method in which user requests identify physical items in a source material library and are "for" compressed information. Because the claim is directed to the same incoherent method disclosed by the specification, the preamble of claim 19 cannot be ignored even if it renders the claim indefinite.

"[t]he entire system includes a transmission system and a reception system. *The transmission system includes a source material library from which a user makes a selection. The selected program is processed and compressed* for storage in a compressed data library." (*Id.* pp. 2-3.)

To determine whether steps in a preamble are important (and are therefore limiting), courts also consider whether the steps are contained in the body of other claims. *See Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1091 n. 1 (Fed. Cir. 1997) (finding preamble limiting where terms also "appear in the body of several asserted claims"). If the applicant deemed the preamble terms important enough to include in the bodies of other claims, those terms are material and should also be treated as limitations in the preamble. Here, the requirement that the transmission system comprises "items" which "contain information" appears only in the preamble of claim 19. However, this limitation appears in the body of claims 1 and 41 (which uses the alternative construct "items having information").[11] In addition, the requirement that the user request identify an item in the source material library is a limitation in the body of claims 25 and 54.

c. reliance on the preamble during prosecution

In addition to the above guideposts, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Marketing*, 289 F.3d at 808. The preamble of claim 19 was amended by the applicants in overcoming prior art rejections. For example, application claim 18 (which issued as claim 19) was rejected in a December 10, 1991 Office Action as obvious over certain Abraham, Ulicki and Keith

[11] This limitation was added to both claims 1 and 19 (application claim 18) at the same time, in an October 1, 1991 Amendment (Benyacar Decl. Ex. E, pp. 2 and 5), in response to examiner rejections of both claims. Claim 41, containing this same limitation, was added to the application in this same amendment, and was represented to the examiner as "correspond[ing] generally" to claim 1 (*Id.* at 17) and as therefore being allowable for the same reasons as claim 1 (*Id.* at 26). The same amendment made to three different claims in response to examiner rejections, at the same time, could not have been intended as a limitation of two of the claims but not the third.

B. The Intrinsic Evidence Supports Round 3 Defendants' Interpretation

The language of the claims, the specification and the prosecution histories all support Round 3 defendants' construction of "distribution method responsive to requests from a user identifying items in a transmission system containing information," namely:

> A user request must contain an identifier of physical items containing information that has not yet undergone the compression recited in the first "storing" step. The physical items must be in the transmission system such that this information can be retrieved from the physical items in response to user requests.

The language of the term itself makes clear that:

- the "user requests" must "identify[] [*e.g.* contain an identifier for] items ... containing information";
- the "items" must be "in [the] transmission system"; and
- the "distribution method" is "responsive to" these user requests, requiring the information in the items to be retrieved and distributed in response to these user requests.

The requirement that the information in the items referred to in the preamble "has not yet undergone the compression recited in the first 'storing' step" follows from the language in the first storing step which requires compression after the information is taken "from items."[14] (See infra Point II.)

The specification and the prosecution history confirm this construction. As described in Point I (A)(1)(b), they state repeatedly that a user request for information contained in physical items in the source material library triggers retrieval and processing of the information in the item.

C. "Items Containing (Or Having) Information"

Relying solely on its contention that the preambles of claims 19, 2 and 5 are not claim limitations, Acacia proposes no construction of its own. However, in a different part of Acacia's brief, it disputes that the term "items ... containing information," which appears in the preamble, requires that items be physical objects. (Acacia Br. p. 19.) Because the Court has previously construed this term, the Round 3 defendants will be heard on the construction of this term during the August 11, 2006 Markman hearing.[15]

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[14] Figure 2 and its associated description also teach that compression occurs *after* the information is retrieved from the physical items in the source material library. See, e.g., the location of "compressor" 116 in Fig. 2a relative to the source material library 111 to which the user's requests identifying "items . . . containing information" are made.

For now, however, we observe only that Acacia is correct that the term "items" is used in the specification in several different ways. As Acacia acknowledges (Acacia Br. 17-18), the specification uses the term "items of information" to refer to the "information" in the source material library (Col. 5:66-6:15) and to "compressed information" stored in the compressed data library. (Cols. 6:35-39; 8:48-52; 11:25-28; 12:55-57.) However, the word "item," when used in the phrase "items containing information" in the preambles of claims 19, 2 and 5, cannot refer either to the "information" itself or to "items" in the compressed data library. Rather, the "items containing information" in the preamble must be physical objects that "contain information," which the specification also describes. (*See*, e.g., cols. 6:10-15; 18:53-59.)

POINT II (JCC # 3)

"STORING, IN THE TRANSMISSION SYSTEM, INFORMATION FROM ITEMS IN A COMPRESSED DATA FORM, THE INFORMATION INCLUDING AN IDENTIFICATION CODE AND BEING PLACED INTO ORDERED DATA BLOCKS" ('992 patent, claims 19 and 47; '275 patent, claims 2 and 5)

Round 3 Defendants' Proposed Construction

This claim term requires all of the following steps, in the stated order:

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[15] Acacia states that: it "does not believe that the Court has construed the term 'items containing (or having) information' in any prior Markman decision;" the Round 3 defendants did not provide Acacia with a citation to the portion of the Court's Markman Order where the Court construed the term; and that the Round 3 defendants are therefore required to brief their construction of "items containing (or having) information" now. (Acacia Br. p. 20.) In fact, the Round 3 defendants did provide Acacia with the citation it requested in an e-mail sent to Acacia attorney Alan Block on April 16, 2006 at 6:01 p.m. Eastern Time. Moreover, Acacia admits that the Court previously construed the term, and quotes the Court's prior construction, just 4 pages earlier. (Acacia Br. p. 16.)

the limitation meant. In a Preliminary Amendment filed in the '275 application shortly after the final amendments to the '992 pending claims were made, applications provided amendments to three pending claims that closely tracked the amendments that were made to the same claims in the '992 application. The applicants argued that the only difference between the amendments made to the claims in the '275 and '992 applications was that the '275 claim amendments added the limitation of a reception system *at a head end*: "The amendments to the claims are similar to those made in allowed claims 1, 18, and 22 *but add a reception system located at the head end of a cable television reception system.*" ('275 4/2/92 Preliminary Amendment; Benyacar Decl., Ex. H, p. 5.) '992 application claim 18 issued as claim 19 of the '992 patent, and '275 application claim 18 issued as claim 2 of the '275 patent. Therefore, what the applicants were telling the examiner is that the only difference between claim 19 and claim 2 is that claim 2 required a reception system at a head end. The applicants are bound by this statement. *See Microsoft Corp.*, 357 F.3d at 1349-50; *Storage Tech. Corp., v. Cisco Sys., Inc.*, 329 F.3d 823, 835 (Fed. Cir. 2003).

As discussed above, claim 5 was added in an amendment dated January 12, 1993 (as application claim 34), and was said to add the transmission media to application claim 18: "Specifically, new independent claims 33-35 further define the transmission media (claim 33), the distribution media (claim 34) and the reception media (claim 35)." (Benyacar Decl., Ex. I.) In other words, claim 5 is the same as claim 2 except for the addition of the "optical fiber communication path" in the body of the claim. Claim 5 too, then, requires a reception system at a cable head end.

POINT XXVI (JCC # 4, #46, #48)

"PLAYING BACK THE STORED COPY OF THE INFORMATION FROM THE RECEPTION SYSTEM TO THE RECEIVING SYSTEM AT THE SELECTED REMOTE LOCATION AT A TIME REQUESTED BY THE USER" ('275, claims 2, 5)

Round 3 Defendants' Proposed Construction

The reception system must play back the stored copy directly onto the receiving system.

The "receiving system" must be a device on which playback can occur - a device which itself can display video content or play audio content directly to a user, such as a television or a radio. (The "receiving system" cannot be a set top box.)

"Playback" and "playing back" refer to the process of sending uncompressed signals to a device, such as an audio amplifier and/or television, on which video information can be displayed and/or audio information heard. These terms are construed similarly in other claims of the '992 and '275 patents.

See also the construction of "time requested by the user" in Point IV above.

Argument

The constructions of "time requested by the user" and "playing back" in claims 2 and 5 are explained in Point IV above, and they have the same meaning in claims 2 and 5 that they have in claims 19 and 47 of the '992 patent. As Acacia correctly observes, however, "receiving system" is used differently in claims 2 and 5 compared to the way it is used in the '992 claims.[48] (Acacia Br. p. 94.)

The last element of both claims 2 and 5 call for the information stored in the reception system to be "played back" to the receiving system. The "playback system" is described in the patent as "a TV or audio amplifier" which can itself display video content or play audio content directly to a user. This is consistent with the definition of "playback" in the dictionaries relied on by Acacia:

- "the action of reproducing recorded sound or pictures often immediately after recording." Webster's Third New International Dictionary, p. 1737 (2002).
- "A term used to denote reproduction of a recording." IEEE 100: The Authoritative Dictionary of IEEE Standard Terms, 7th Ed., p. 834, IEEE Press (2000).

Therefore, if Acacia is correct that the receiving system need not be a device which can display video content or play audio content directly to a user, such as a television or a radio, then the recorded information is not being reproduced at all, meaning there is no playback. Acacia's construction thus contradicts the plain language of the claim.

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[48] For this reason, the Round 3 defendants do not consider "receiving system" as used in the '275 patent to be a term that the Court has already construed, and we are therefore addressing it now.

Acacia argues that Round 3 defendants' construction is wrong because the specification discloses "that the play back signal is either sent to a playback device (television or audio amplifier) or is sent to an audio/video recorder for recording." (Acacia Br. at 103.) That is not what the passage relied on by Acacia states. It states is that the signals *are* sent "to a playback system such as a TV or audio amplifier" and "*may also*" be sent "to an audio/video recorder of the user." (17:25-28.) The signals must be sent to the playback device, and may optionally be sent to an audio/video recorder.

POINT XXVII (JCC #7)

"USER" ('992, claims 19, 47 and '275, claims 2, 5)

Round 3 Defendants' Proposed Construction

A user is a human.

Argument

The term "user" is used in the specification exclusively to refer to a human. For example, a user is repeatedly referred to as a "he or she" (Cols. 3:58-60; 12:10-12; 12:20-21; 18:53-59), and users are described doing such things as making telephone calls from work and then going home (Col. 5:18-21), making calls and typing commands into a computer (Col. 3:54-58), "remotely select[ing] audio/video material from any location that has either telephone service or a computer" (Col. 1:62-66), and watching, listening to and viewing material (Cols. 3:60; 5:28). Since Acacia never disputes that a user is a human, Round 3 defendants do not feel it is necessary to itemize all of the overwhelming intrinsic evidence for this common sense proposition.

The Court should construe "user" to mean "a human."

Respectfully submitted,

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KAYE SCHOLER LLP

/s/ David S. Benyacar

David S. Benyacar
Daniel L. Reisner
425 Park Avenue

New York, NY 10022-3598
Tel.: (212) 836-8000
Fax: (212) 836-8689
dbenyacar@kayescholer.com
dreisner @kayescholer.com

Attorneys for Defendant
Time Warner Cable Inc.

GOODWIN PROCTER LLP

/s/ Benjamin Hershkowitz
Benjamin Hershkowitz
John F. Petrsoric
599 Lexington Avenue
New York, NY 10022
Tel.: (212) 813-8800
Fax: (212) 355-3333
bhershkowitz@goodwinprocter.com
jpetrsoric@goodwinprocter.com

Attorneys for Defendant
CSC Holdings, Inc.